

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Serial No.: 09/385,394 Confirmation No.: 9093  
Applicant: John S. Yates, Jr., et al.  
Title: COMPUTER WITH TWO DIFFERENT EXECUTION MODES  
Filed: August 30, 1999  
Art Unit: 2183  
Examiner: Richard Ellis  
  
Atty. Docket: 114596-03-4000  
Customer No. 38492

**AFTER FINAL – EXPEDITED PROCEDURE**

**REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Applicant requests that the premature finality of the Action of October 25, 2004 be withdrawn – that is, that prosecution be reopened – and that the Response to Office Action and Information Disclosure Statement filed herewith be entered as of right.

**I. Claim 104 has Not Been Examined, and No “Clear Issue” is Developed – It Cannot Be Finally Rejected**

37 C.F.R. § 1.113 reads as follows:

**37 C.F.R. 1.113. Final rejection or action.**

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

I certify that on January 25, 2004 this correspondence, along with any documents referred to therein, is being transmitted by facsimile to Art Unit 2183 at FAX no. 703 872 9306 and deposited with the United States Postal Service as First Class Mail in an envelope with sufficient postage addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

MPEP § 706.07 elaborates on § 1.113, as follows, emphasis added:

**706.07 Final Rejection**

Before final rejection is in order a clear issue should be developed between the examiner and applicant.

....

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's reply.

Claim 104 was briefly mentioned in paragraphs 10 and 42 of the Office Action of February 2004 in the context of **Goetz '913 alone**. Because the Office Action of February 2004 made no element-by-element comparison of claim 104 to Goetz '913 or any other reference, no rejection was raised in February 2004.

Applicant's paper of July 2004 went well beyond the duty of an applicant – Applicant made a reasonable guess at what the Examiner's position might be, and fully responded by showing that certain language of claim 104 is not met by the single reference mentioned in the relevant portions of the February Office Action.

Paragraph 14.7 of the Office Action of October 2004 states that “one cannot show nonobviousness by attacking references individually.” The October Action is a *non sequitur* – only one reference was cited against claim 104 in February 2004, and obviousness of claim 104 was never suggested before October. Thus an attack against the single reference applied is totally proper. The failure of the October Office Action to “Answer All Material Traversed” is a breach of Patent Office procedures, and prevents final rejection.

Taken together, the two Office Actions raise confusion, not a rejection. It is totally impossible to discern the Examiner's position – is it based on Goetz '913 alone, or on some combination of references? Does the October Office Action purport to switch from § 102 to § 103? Does the Examiner believe that Goetz '913 teaches the claim limitation discussed in the July 2004 response (two memory regions that “[follow] first and second data storage conventions”), or not? If so, where? By failing to “Answer All Material Traversed,” MPEP

§ 707.07(f), does the October Office Action concede that the “instruction” of claim 104 is absent from the one reference relied upon?

Further, claim 104 recites two memory regions that are “necessarily disjoint.” Neither Office Action mentions this limitation. If the October Office Action raises any rejection of claim 104, then it is a “new ground of rejection not necessitated by amendment” which renders final rejection premature.

Without some “[clear statement] of reasons in support” of any rejection – a designation of a particular part of a particular reference, and a “clear explanation” of the “pertinence” of that portion, 37 C.F.R. § 1.104(c)(2) – the October Office Action fails to comply with the prerequisites for examination, let alone final rejection set forth in 37 C.F.R. § 1.113(b). Final rejection on unstated grounds exceeds the Examiner’s authority.

Further, MPEP § 706.07 makes clear that where neither a reference nor a particular part of a reference are designated, no “clear issue” is developed for appeal. It is impossible to appeal from a position that the examiner has not articulated – the Board simply refuses to entertain the appeal. *E.g., Ex parte Schricker*, 56 USPQ2d 1723, 1725 (Bd. Pat. App. & Interf. 2000) (“The examiner has left applicant and the board to guess as to the basis of the rejection and after having us guess would have us figure out (i.e., further guess) what part of which ... document supports the rejection. We are not good at guessing; hence, we decline to guess.”). Until a “clear issue” is developed, MPEP § 706.07 makes clear that final rejection is premature.

For each of these reasons, final rejection is premature.

## **II. No “Clear Issue” Is Developed for Claim 22 – Final Rejection is Therefore Premature**

Claim 22 is discussed at paragraph 52 of the Office Action of the February 2004 and paragraph 14 of the October 2004 Office Action. Paragraph 52.4 of the February Action compares the “the indicator elements each having a value indicating the data storage convention under which instructions from the associated region are to be executed” to Goetz ’913, col. 17, lines 24-33 **and to no other portion of any reference.**

Applicant's paper of July 2004 fully responded to the February 2004 Action, by showing that this language is not met by the indicated portion of Goetz '913 (Response to Office Action of July 2004, at 34).

The October Office Action makes no "rebuttal" responsive to the July showing. The October Action makes no showing that the "indicator elements" of claim 22 are met by col. 17 or any other portion of Goetz '913. Nor does the October Action indicate any other portion of any other reference that might be thought to correspond. Instead, the October Office Action responds with a *non sequitur*, that the claim language might correspond to some unspecified portion of some unspecified reference.

For much the same reasons as stated above in connection with claim 104, there is no rejection of claim 22, let alone a final rejection – there is no coherent statement of any rejection that might be pending.

### **III. The Office Action of October 2004 Raises a New Ground of Rejection of Claim 87, an Unamended Claim**

Since its original filing in 1999, claim 87 has recited "control-transfer instruction of a computer ... architecturally defined to transfer control directly to a destination instruction."

The discussion of claim 87 in the Office Action of February 2004 (see paragraph 100) was too brief to constitute a rejection. The February Action only suggested that there was some issue relating to unspecified portions of Goetz '913, Brender '422, and Murphy '947, combined in some unspecified way. The February Action was no more than an invitation to Applicant to attempt to guess at the ground of rejection – it was not itself a rejection. Therefore, if any rejection exists in the October Office Action, it is a new ground, not necessitated by amendment.

The Office Action of October 2004 now for the first time compares this language of claim 87 to a designated portion of a reference. The portion now relied upon was never cited in the previous Office Action. If the October Action is sufficient to raise a rejection at all, it does so by raising a new ground of rejection not necessitated by amendment.

For these reasons, the October Office Action is either insufficient to support final rejection of claim 87, or raises a new ground was not necessitated by any amendment. Under MPEP § 706.07(a), finality of the Action of October 2004 is premature.

#### IV. Examination of the Application as of October 2004 was Not Completed

A number of references submitted on the Form 1449 filed July 12, 2004, and returned with the Action of October 2004 are crossed off without consideration. Contrary to the statement in the Office Action, legible copies of all required references were made available in parent applications that were identified in the Information Disclosure Statement. The Information Disclosure Statement of July 2004 contained the following statement, pursuant to 37 C.F.R. § 1.98(d):

3. For non-patent items listed on the enclosed Form PTO-1449 for which a copy is not already made of record in this application, a copy was previously cited by or submitted to the Patent and Trademark Office in application Serial No. 09/239,194, filed January 28, 1999, Yates et al., Executing Programs for a First Computer Architecture on a Computer of a Second Architecture, in application Serial No. 09/322,443, filed May 28, 1999, Reese et al., Profiling of Computer Programs Executing in Virtual Memory Systems, or in application 09/626,325, filed July 26, 2000, Yates, et al., Computer with Two Operating Systems.

The IFW's of the parent applications identified in the IDS reveal that copies of the references refused consideration were indeed made of record in these parent applications on the dates, and with the number of pages, indicated:

	09/239,194	09/322,443
WO 99/08188 Kelly	5/6/03 101	
WO 99/08191 Kelly	5/6/03 88	
T.M. Conte, et al., "Accurate and practical profile-driven compilation using the profile buffer" (Dec. 1996)	4/21/03 10	11/26/99 12
T.M. Conte, et al., "Hardware based profiling: An effective technique for profile-driven optimization" (Feb. 1996)	4/21/03 39	11/26/99 39
T.M. Conte, et al., "Using branch handling hardware to support profile-driven optimization" (Dec. 1994)	4/21/03 11	11/26/99 11
J.S. Cox et al., "Commercializing profile-driven optimization." (Jan. 1995)	4/21/03 8	11/26/99 20*
Dean, ProfileMe: Hardware Support for Instruction-Level Profiling on Out-of-Order Processors," IEEE 1997, pp. 292-302	5/6/03 12	9/30/04 12
R.E. Hank, et al., Proceeding of the 28 <sup>th</sup> Annual International Symposium on Microarchitecture, pp. 158-168 (Dec. 1995)		11/26/99 20*
Intel Corporation, Intel Processor Family Developer's Manual (1997), pages 1-1 to 1-6, 2-1 to 2-20	4/21/03 43**	9/30/04 **
Intel Corporation, Intel Processor Family Developer's Manual (1997), vol. 3 (Architecture and Programming Manual), pages 3-1 to 3-3, 3-10 to 3-13, 12-1 to 12-27, 14-1 to 14-30		9/30/04 **

Kim and Tyson: Analyzing the Working Set Characteristics of Branch Execution (Dec. 1998)	5/6/03 10	9/30/04 10
Larus and Schnarr: EEL: Machine-Independent Executable Editing, EEL: Machine-independent executable editing (1995)	5/6/03 11	9/30/04 11
M. Lipasti and J. Shen. Exceeding the Data-Flow Limit Via Value Prediction (Dec. 1996)	5/6/03 11	9/30/04 11
K.N.P. Menezes, "Hardware-based profiling for program optimization" (1997)	4/21/03 124	11/26/99 124
Veen: Dataflow Machine Architecture, ACM Computing Surveys vol. 18 no. 4 pp. 365-96 (December 1986)	5/6/03 32	9/30/04 32

\* The Cox and Hank references are combined as a single "NPL Document" entry in the '443 IFW.

\*\* The two Intel references are combined as a single "NPL Documents" entry in the '194 IFW. They are split into a number of separate small documents in the '443 IFW.

Because "present practice" was violated in the Office Action of October 2004, MPEP § 706.07(a) does not authorize final rejection. Because final rejection was not authorized, prosecution should be reopened so that the Examiner can make a good faith effort to examine the entire application.

## V. Conclusion

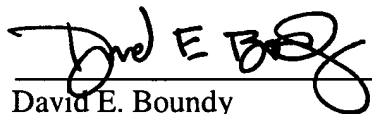
For these reasons, the finality of the Action of October 2004 should be withdrawn – that is, prosecution should be reopened. The accompanying Response to Office Action should be entered as of right (even without a showing of reasons under Rule 116).

It is believed that this paper occasions no fee. Kindly charge any fee due to Deposit Account No. 23-2405, Order No. 114596-03-4000.

Respectfully submitted,

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Dated: January 25, 2004

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**CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)**

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I hereby certify that the attached

- Return postcard
- This Certificate of Mailing
- Request to Withdraw Finality of Office Action
- Response to Office Action
- Information Disclosure Statement and Form PTO-1449
- 3 references

(along with any paper(s) referred to as being attached or enclosed) are being deposited with the United States Postal Service on the date shown below with sufficient postage as first-class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Respectfully submitted,

**WILLKIE FARR & GALLAGHER LLP**

Dated: January 25, 2004

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